

## **REMARKS**

Claims 1-9, 19, 20, 22-27, 31, 32, 34-36, 39, 40, and 42-50 are now pending in the application. Claims 21, 28, 29, 30, 33, 37, and 38 are canceled and Claims 43 - 50 are added by this Amendment. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

## **INTERVIEW**

Applicants' representative attempted, but failed, to reach the Examiner to interview the present Application in substance. The Examiner, however, agreed to enter any supplemental amendments that are made after a telephonic interview scheduled for July 10, 2007.

## **ELECTION REQUIREMENT**

The Examiner has made the species requirement final and states that Claims 25-35 do not read on the elected species. Although Applicants respectfully disagree with the Examiner's position, Applicants wish to expedite the prosecution of the current application. Therefore, if any of the generic claims are found in condition for allowance, Applicants request that Claims 25-35 be rejoined and examined with the current Application. Further, Applicants reserve the right to petition to have the species requirement removed or changed.

## **SPECIFICATION**

Applicants have amended the specification according to the Examiner's suggestions. Therefore, reconsideration and withdrawal of this objection is respectfully requested.

## **REJECTION UNDER 35 U.S.C. § 102 AND 103**

Claims 1-5, 9, and 39-40 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Huebner (U.S. Pat. No. 5,868,789). Claims 19, 20, 21 and 24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Martello (U.S. Pat. No. 6,168,598 B1). Claims 6, 7, 41 and 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Huebner in view of Martello. Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Huebner in view of Martello as applied to the claims above, and further in view of Borzone et al. (U.S. Pat. No. 5,814,070). Claim 23 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Martello. Claim 22 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Martello in view of Borzone et al. These rejections are respectfully traversed.

Huebner is directed to a suture anchor that has an eyelet 50 formed in post 46 with a beveled edged to reduce wear on the suture. See col. 5, lines 19-21. A suture is threaded through the anchor **eyelet** prior to installation. See col. 5, lines 39-40. As illustrated throughout the drawings of Huebner, the eyelet 50 extends from a side of the post 46 and when inserted into the bone is clearly below the surface of the bone and the suture 72 is exposed to the cortex bone 114. (See Fig. 6)

Martello is directed to a soft tissue securing anchor. The anchor includes a head 11 and a shoulder 50 that delineates the head from the shank 17. The shoulder 50 is disclosed to raise a lower aperture off the bone to permit easy access to lower aperture. See col. 4, lines 11-12. An anchor is disclosed to have a lower and upper aperture that extends directly between the two. Several embodiments are illustrated that include slight variations, as illustrated in Figs. 4A – 5B of Martello. Martello also describes that anchor holes can be formed at an angle zero degrees to a plane that is perpendicular to a long axis of the member. See col. 5, lines 48-50. The anchor holes are provided to allow a suture to be threaded through the anchor holes and include a chamfer to remove sharp edges. See col. 4, lines 47-67.

Borzone et al. is directed to a suture anchor, as illustrated in Fig. 6, which includes a slot 38 for placement of suture material. The slot 38 eliminates the need to thread the suture material. See col. 4, lines 14-16. Therefore, Borzone et al. teaches **away** from a combination with either Martello or Huebner in that Borzone et al. specifically teaches placing the thread in a slot and the elimination of threading. Both Martello and Huebner only disclose threading or passing a suture through an eyelet. Borzone et al. further teaches a cradle 20, as illustrated in Fig. 4, which is contrary to “conventional eyelet design”. Again, this teaches away from a combination with either Martello or Huebner. Borzone et al. disparages eyelet or threading configurations, as illustrated above.

Independent Claim 1, contrary to Huebner et al. recites “an eyelet formed in said suture engaging section to allow a selected portion of a suture to pass through and extend from said suture engaging section generally along said bone engaging axis; and

a suture passage defined by said suture engaging section such that the selected portion of the suture remains substantially within said maximum diameter.” Although independent Claim 1 has been amended, it has been amended purely to ensure appropriate antecedent basis for “axis” by including -bone engaging-. Nevertheless, Huebner in no way teaches or renders apparent an eyelet formed in a suture engaging section or a suture passage defined by a suture engaging section such that a selected portion of the suture remains substantially within the maximum diameter. As clearly illustrated in Huebner, for example in Fig. 6 of Huebner, the suture 72 not only is able to engage bone 14, but is clearly in no way made to remain within the maximum diameter of any portion of the anchor. Therefore, Huebner does not anticipate independent Claim 1. Therefore, independent Claim 1, and each of the claims that depend directly or indirectly therefrom, is in condition for allowance.

Contrary to Martello, independent Claim 19 recites “a suture engaging section . . . wherein said suture engaging section is adapted to be positioned generally within a sidewall defined in said selected anatomical portion.” As described and illustrated clearly in Martello, any portion that is to engage a suture extends above an anatomical portion. In addition, many embodiments also include a shoulder 50. Therefore, Martello can not anticipate each of the elements of independent Claim 19.

Moreover, various of the claims that depend directly or indirectly from independent Claim 19 include patentable subject matter. Dependent Claim 24 recites “said suture engaging section is generally co-extensive with an exterior portion of said selected anatomical portion.” As discussed above, Martello clearly does not anticipate a co-extensive suture engaging section.

Regarding Claims 6, 7, 41 and 42, rejected under the combination of Huebner and Martello, Applicants respectfully submit that Huebner and Martello can not be combined as asserted in the Office Action. Initially, as discussed above, Martello specifically describes that the eyelets are exposed for threading a suture, and this can be assisted with the shoulder 50, as illustrated in Fig. 1. Contrary to this, Huebner discloses that an anchor can be embedded completely within a bone, including the post that includes the eyelet 50. See Fig. 6 of Huebner et al. Therefore, the combination of Huebner and Martello appears to be improper. Not only is it not apparent to combine Martello and Huebner, but the combination would not allow for either Huebner or Martello to operate as disclosed. Further, the combination of Martello and Huebner does not teach each of the elements of independent Claim 1, such as allow a selected portion of the suture to pass through and extend from said suture engaging section along said bone engaging axis.

Regarding Claim 8, which recites "wherein said suture passage allows a suture to be passed to an exterior of said suture engaging section at a point other than said first eyelet and second eyelet", Applicants respectfully submit that this limitation is not taught or disclosed in any of the references cited in the Office Action. As discussed above, Borzone et al. is not properly combined with Huebner and Martello. Moreover, the embodiment of Borzone et al Fig. 6 discloses that the slot 38 eliminates the need for threading. See col. 4, lines 14-16. Therefore, Borzone et al. teaches away from passing a suture through any eyelet, and Martello and Huebner clearly illustrate that only the eyelets allow a suture to be passed relative to the anchor. No slot is taught in

Martello or Huebner. Therefore, dependent Claim 8 is neither disclosed nor rendered apparent by any of the cited references.

#### **NEW CLAIMS**

New Claims 43-46 are added by this Amendment. Support can be found for the new claims throughout the Application as filed, including the figures.

Applicants submit that the new claims are also both not anticipated and not obvious in light of the cited art. For example, dependent Claim 43 recites “wherein at least a portion of said suture passage defines an enclosed bore extending substantially parallel to said bone engaging axis.” Applicants respectfully submit the cited art in combination or alone do not render dependent Claim 43 unpatentable.

Dependent Claim 44 recites “wherein said suture holding passage includes an enclosed passage defined in a suture engaging section; wherein the suture is operable to be held completely within said suture engaging section via said suture holding passage.” Again, Applicants respectfully submit that dependent Claim 44 is patentable in light of the cited art.

New Claim 45 recites “wherein said first suture eyelet and said second suture eyelet are both formed through one surface of said suture engaging section.” Dependent Claim 45 depends from independent Claim 19 which recites “a suture holding passage interconnecting said first suture eyelet and said suture eyelet.” Applicants respectfully submit that a passage and eyelet as recited in Claim 45 is patentable and in condition for allowance.

New dependent Claim 46 recites "wherein said eyelet includes a first eyelet and a second eyelet both formed through a proximal face of said suture engaging section and said suture passage interconnects said first eyelet and said second eyelet." Applicants respectfully submit that the cited art, either alone or in combination does not disclose or render apparent dependent Claim 46.

Finally, new independent claim 47 recites, "a suture engaging portion defining a diameter less than or equal to said maximum diameter and having an end surface; at least two eyelets formed in said end surface of said suture engaging portion to allow a selected portion of a suture to pass through and extend from said suture engaging portion generally along said bone engaging axis". Applicants respectfully submit that the cited art, either alone or in combination does not disclose or render apparent Claim 47 for at least the reasons recited above. New Claims 48-50 depend from Claim 47 and should be in condition for allowance at least for these reasons as well.

Therefore, Applicants respectfully submit that each of the claims presently pending are in condition for allowance and request that the Examiner indicate allowance of each of the claims in a future Office Action.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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